

ARGUMENT

Claims 1-22 are active.

Claims 3, 6, 9, 10, 12-20, and 22 are withdrawn.

Claims 1, 2, 4, 7, 8, 11 and 21 are rejected.

The claims have been amended to further define the substituent "G" in the claims as supported in the specification on page 21, lines 15-19. This amendment is presented in lieu of the prior filed Appeal Brief based on a telephone discussion between the undersigned and Examiner Havlin.

For the record, Applicants reiterate their previous arguments as to the inapplicability of the cited Hasegawa publication.

1. The cited Hasegawa *et al* publication is not available as prior art for which it was cited

The present 371 application was filed on April 28, 2006 of a PCT application filed on July 27, 2004 and claims the benefit of European (EP) application 03102313.8 filed July 27, 2003, which fully supports the claimed invention.

The Hasegawa *et al* publication is available as prior art against this application based on the U.S. provisional application serial no. 60/428,384 to which it claims priority (35 U.S.C. § 102(e)). The provisional application of the Hasegawa *et al* publication was filed on November 22, 2002, which is prior to the earliest date to which the present application claims priority (EP application filed July 28, 2003). However, for the rejection to be sustained, the provisional application must support the subject matter upon which the Examiner relied in the rejection.

Example 107 (at page 35), i.e., the compound identified in the rejection was NOT present in that provisional. A copy of the Hasegawa *et al* provisional application was previously made of record in this application.

Therefore, the earliest effective prior art date of the Hasegawa *et al* publication for the subject matter relied upon in the rejection is the date the PCT was filed (November 18, 2003). While this date is before the filing date of the PCT application from which the present 371 application was filed, it is after the date of the European Patent application, July 27, 2003.

As Applicants European priority application provides support for the claims in the present U.S. application, the Hasegawa *et al* publication is not applicable prior art under 35 USC 102(e). In the Advisory Action of September 3, 2009, the Examiner stated at page 2:

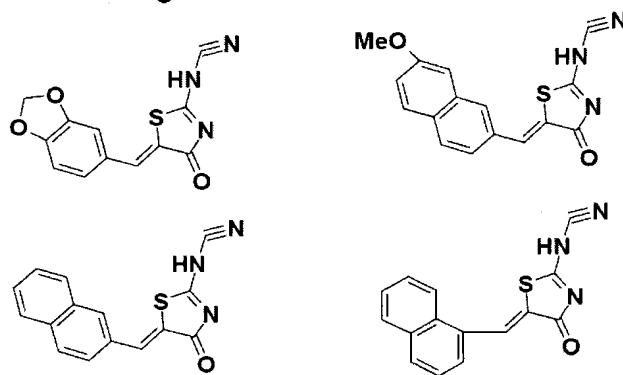
Applicant also argues the priority date of the instant claims are earlier than the cited prior art. Upon review of the priority documents, limitations are presently in the claims that were not in the certified priority documents, therefore the priority date for the claims is the filing date of this application. Specifically, the limitations are the four additional proviso-ed compounds.

The Examiner's finding that the full scope of the subject matter defined in the pending claims, including the exclusionary proviso, is not described in EP 03102313.8 in the manner required under 35 U.S.C. § 112, 1st paragraph, is clearly erroneous. EP 03102313.8 shows that the Applicants were in possession of the full scope of the invention positively defined by the current claims as of its filing date.

Each of the limitations of Claim 1 and the supporting disclosure in EP 03102313.8:

1. The structure of formula (I) is disclosed on page 7, lines 7-9.
2. The definition of A is disclosed on page 17, lines 11-12.
3. The definition of X is disclosed on page 18 line 17.
4. The definition of Y is disclosed on page 18, line 19.
5. The definition of R¹ is disclosed on page 18, line 20 to page 19, line 4.
6. The definition of R² is disclosed on page 19, lines 6-22.
7. The definition of G is disclosed on page 19, line 24 to page 20, line 2.
8. The definition of R³ is disclosed on page 18, lines 17-18.
9. The first four structures of the 8 compounds excluded from the claims are disclosed on page 20, starting at line 5.

10. The last four structures of the 8 compounds excluded from the claims are:



a. Support is found in the disclosure for each of the substituent groups for formula (I) at least at:

- i. X at page 18, line 17
- ii. Y at page 18, line 19
- iii. R¹ at page 18, line 20 to page 19, line 5
- iv. R² at page 19, lines 7-22
- v. A at page 17, line 11 to page 18, line 16.

While the specific structures of the last four compounds excluded from Claim 1 are not depicted in structure form like the first four, they need not be. See *In re Parks*, 30 USPQ2d 1234 (BPAI 1994) and (*In re Johnson*, 558 F2d 1008 (Fed. Cir. 1977)).

As is made clear in the present application, different types of substitutents and compounds are disclosed. The claims as defined make clear that the claims cover certain aspects of the disclosed compound falling within the general formula (I) at page 7 and do not cover other compounds. Such an exclusionary limitation is proper under MPEP 2173.05(i).

In *In re Parks*, the Board reversed the Examiner's new matter/written description rejection of claims containing the negative limitation "in the absence of a catalyst." In reversing the rejection, the Board stated (1) "clearly, the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive

support” (*Id* at 1236). Here, the specification conveys that Applicants had possession of the compounds defined in the claims excluding some others. Applicants’ possession of the concept is evident at least in the portions of the EP application detailed above.

Similarly, the Federal Circuit’s decision in *In re Johnson* dictates withdrawal of the pending rejection as well. In *In re Johnson*, the issue was whether provisos excluding particular species which had been disclosed in the application constituted new matter/failed to satisfy the written description requirement. In holding that the provisos were proper, the Federal Circuit stated (at page 1019):

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened is that appellants narrowed their claims to avoid having them read on a lost interference count.

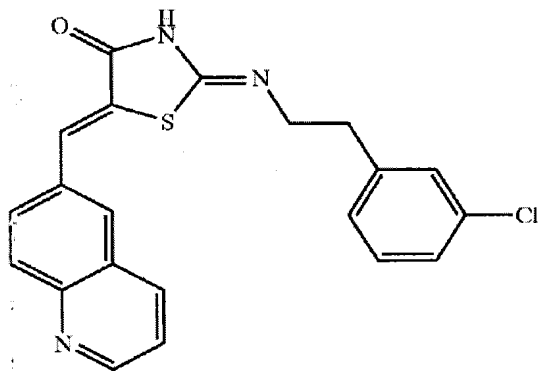
Similarly, here, all that is happening is that Applicants have presented claims to focus on fully disclosed embodiments to the exclusion of other embodiments. Thus, written descriptive support for the full-scope of the claims is positively found in the EP application.

Support for the present claims in the pending application is shown using Claim 1 as illustration in the Summary of Claimed Subject Matter detailed earlier in this brief. As the present application is a 371 of PCT/EP2004/051625, support for the subject matter in the claims is found at the same pages of the PCT application.

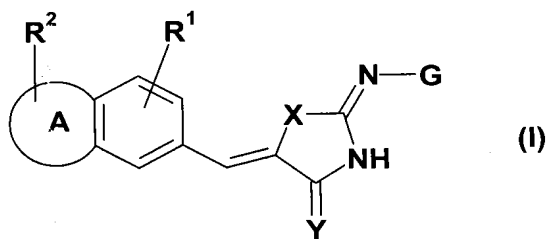
2. The reliance on Example 107 in the Hasegawa *et al* publication and the Hasegawa provisional application in the Advisory Action is erroneous

In the final Office Action, the Examiner cited to a CAS database search corresponding to Example 107 ([00372]) in the publication. Example 107 does not fall within the scope of the defined subject matter in the claims.

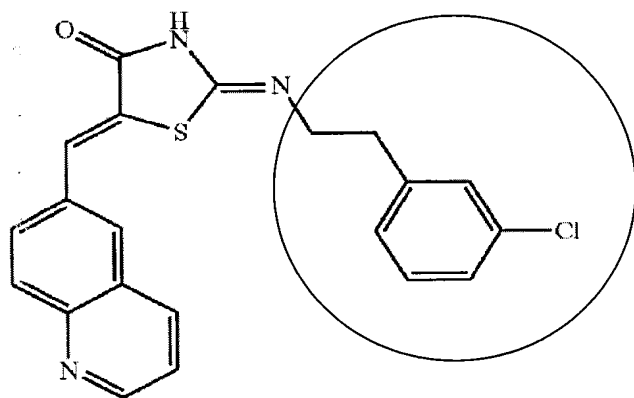
Example 107 is:



The compound of formula I set forth in Claim 1 (see Appendix I):



As set forth in Claim 1 of the present application, G is “a C₁-C₆-alkoxy, unsubstituted C₁-C₆-alkyl, C₂-C₆-alkenyl, C₂-C₆-alkynyl, unsubstituted C₁-C₆-alkyl aryl, or a sulfonyl moiety” (see Appendix I). Now looking at Example 107 with emphasis added to a portion of the molecule that corresponds to “G” in the claimed formula (I).



G in the compound of the claims cannot be the alkyl-phenyl substituted by chlorine that is required in example 107.

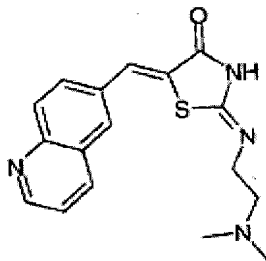
3. The reliance on Example 64 in the Hasegawa *et al* publication and the Hasegawa provisional application in the Advisory Action is erroneous

In the Advisory Action mailed August 14, 2009 at page 2, the Examiner newly cited Example 64 stating:

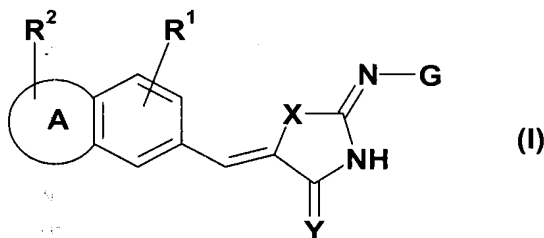
Continuation of 11. does NOT place the application in condition for allowance because: the prior art cited anticipates the claims and the CAPLUS document provides examples within the scope of the claims. See for example "Example 64" in the provisional application as well as the other numerous species therein which anticipate the claims. Therefore, the claims were properly rejected under 102(e).

Example 64 from page 45 of the provisional application (which is also found in the Hasegawa *et al* publication at page 26, paragraph [0280]) is:

Example 64
2-(2-Dimethylamino-ethylimino)-5-quinolin-6-ylmethylene-thiazolidin-4-one



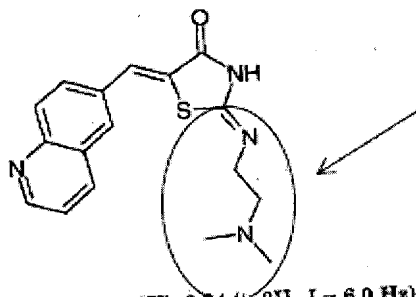
The compound of formula I set forth in Claim 1 (see Appendix I):



As set forth in Claim 1 of the present application, G is "a C₁-C₆-alkoxy, unsubstituted C₁-C₆-alkyl, C₂-C₆-alkenyl, C₂-C₆-alkynyl, unsubstituted C₁-C₆-alkyl aryl, or a sulfonyl moiety" (see Appendix I). Now looking at Example 64 with emphasis added to a portion of the molecule that corresponds to "G" in the claimed formula (I).

Example 64

2-(2-Dimethylamino-ethylimino)-5-quinolin-6-ylmethylene-thiazolidin-4-one



$^1\text{H NMR}$ (400 MHz, CDCl_3) δ 2.80 (s, 6H), 3.24 (t, 2H, $J = 6.0$ Hz), 3.94 (t, 2H, $J =$

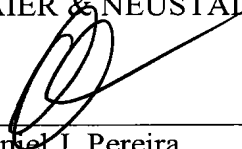
G in the compound of the claims is not a dimethyl amino substituted ethane group that is required in example 64.

Therefore, like the previous Example 107, Example 64 of the provisional application or the Hasegawa publication does not fall within the scope of the claims. The examples of the Hasegawa *et al* provisional application do not include any compound falling within the scope of the claims.

It is respectfully requested that the rejection be withdrawn, consider and search the non-elected species, and a Notice of Allowance indicating all pending claims are allowable.

Respectfully submitted,

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